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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,325	12/04/2001	Michael S.H. Chu	-06530.0285-00000.	9761
22852	7590	06/16/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/000,325	CHU, MICHAEL S.H.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39,61-107,109,112,115 and 118 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39,61-107,109,112,115 and 118 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 9, 2006 has been entered.

Claims 1-4, 7-10, 14-26, 30-34, 38, 39, 61-64, 67-70, 74-90, 94-98, 102-107, 109, 112, 115 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (6,059,719). Yamamoto et al., in figures 16-17, disclose elongate member (the combination of wires 137 and 22 which are secured together at 8a and 24 to form a single member) for insertion into a channel 20 of the endoscope 2, distal assembly 7 having an open configuration and a closed configuration wherein a proximalmost end surface of the distal assembly (at the right end of the distal assembly 7) substantially transverse to the elongate member has a diameter larger than a diameter of a distalmost end of the channel 20 of the endoscope 2, wherein the distal assembly includes a tube (the tubular channel which receives wire 137) and an end effector (jaws 135 and 136). Yamamoto et al., in this embodiment, fail to disclose at least a

Art Unit: 3731

portion of the end effector 135, 136 fitting within the lumen of the tube when in the closed configuration. However, Yamamoto et al., in the embodiment of figure 22 and the embodiment of figure 13 teach that the jaws 132-134 should be flexible and be pulled within the lumen of the tube when in the closed configuration in order to obtain the advantage of being evacuated from the field of view and thus facilitate observation efficiency (col. 13, lines 32-36 and 45-54). It would have been obvious to make the jaws 132-134 in the embodiment of figures 16-17 flexible and be pulled within the lumen of the tube when in the closed configuration so that it too would have this advantage. As to claim 3, Yamamoto et al. disclose a stop at 17b. As to claim 7, Yamamoto et al. disclose attachment cup 71. As to claim 8, the activation shaft is inherently capable of rotating the distal assembly when the activation shaft is rotated. As to claim 9, the distal end of the activation shaft is bent when it is in a curved path in the body. As to claim 10, the distal assembly is inherently capable of obtaining and storing multiple small samples. As to claim 15, Yamamoto et al. disclose ring 24. As to 20, 21, 80, 81, 83, 84 and 105-107, the proximal portion of each member 132-134 is a spring since it is elastic and biased outwardly while the distal portions of members 132-134 are considered to be the claimed jaw members.

Art Unit: 3731

Claims 5, 6, 11-13, 27-29, 35-37, 65-66, 71-73, 91-93 and 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (6,059,719) in view of Townsend et al. (6,066,102). As to claims 5, 6, 27-29, 65, 66 and 91-93, Yamamoto et al. fail to disclose the details of the handle with the slide. However, it is old and well known in this art to so construct handles for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses casing (the frame on which handle 42 slides), slide 46, cap (at the proximal end of the frame), knob 44, 42 and a groove (the groove that 44 slides in). It would have been obvious to so construct the Yamamoto et al. handle so that it too would have this advantage. As to claims 11-13, 35-37 and 71-73, Yamamoto et al. fail to disclose the details of the distal assembly and elongate member. However, it is old and well known in this art to so construct a 1) distal assembly and 2) an elongate member in order to obtain the advantage of 1) performing specific operations and 2) for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses needle 718 and a lumen 28 to receive a medical device (col. 6, lines 44-55). It would have been obvious to so construct the Yamamoto et al. distal assembly and elongate member so that it too would have this advantage.

Art Unit: 3731

Applicant's arguments with respect to claims 1-39, 61-107, 109, 112, 115 and 118 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
6/9/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731